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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,732	10/30/2000	Michael J. Hearn	5143	6916

7590

08/07/2002

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EXAMINER

ROBINSON, BINTA M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 08/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/699,732

Applicant(s)

HEARN, MICHAEL J.

Examiner

Binta M. Robinson

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1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7,8,17 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,7,8,17 and 21-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u> . | 6) <input type="checkbox"/> Other: _____ |

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D tailed Action

The 112, first paragraph rejection of claims 1-2, 17 made at paper no. 9 and the 112, second paragraph rejections of claims 1 and 17 made at paper no. 9 as well as the 102 (b) rejection of claims 1-2 and 17 made at paper no. 9 are withdrawn in light of applicant's amendment and remarks at amendment 10/a.

✓ The applicant did not adhere to the agreement that was reached in the interview at paper no. 10 in which it was agreed that if R1 and R2 were taken together, that taken together they would form only substituted carbocyclic groups. The applicant apparently has allowed for R1 and R2 to come together to form heterocyclic groups.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7, 8, 17, and 21 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Whether or not "R1, R2" as well as "R1R2" can independently be the substituents claimed or whether or not they come together to form a ring from the claimed substituents critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Whether or not the phrase "R, R2" in line 1 of claims 7 and 8 on pages 2 of the amendment 10/a and "R1R2" on line 8, in claim 21, line 3, page 4, claim 17, page 3 of the amendment 10/a refers to "R1" and "R2" independently representing the substituents claimed or coming together to form a ring from the substituents claimed is essential to the invention, because it is critical to know

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what the applicant's invention is via knowing what compounds the applicant is claiming. For example it is not clear in claim 7 if R1 and R2 can come together to form a pyridine ring that is then further substituted as indicated by "R1, R2" equaling "4-C6H8NNHCO-4-C5H4N". If in claim 7, R1 and R2 can come together to form pyridine ring, then this component of the claim would be nonelected.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 7, 8, 17, 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ A. In claims 7, and 8, line 1 of the amendment 10/a, and in claim 21, line 3, the phrase "R1, R2" is indefinite and ambiguous. It is unclear as to whether or not "R1, R2" is independently representing the substituents claimed or coming together to form a ring from the substituents claimed.

keep B. In claim 17, line 8, page 3, the phrase "R1R2" is indefinite and ambiguous. It is unclear as to whether or not "R1R2" independently representing the substituents claimed or coming together to form a ring from the substituents claimed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 17, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Borstel et. al. (See Reference U). Borstel discloses the instant compounds, 472, 477, 476, 478, 504, 506, 508, 509, 510, 511, 513, 517, 521. At pages 307-312, see the instant compounds.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ca 2103f (See Reference V). Ca 2103f discloses the instant compound, Isonicotinic acid, (1-naphthylmethylene)hydrazide. At column 2103f, see the instant compound.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ca 59: 13326a. (See Reference W). Ca 59:13326a discloses the instant compound, Isonicotinic acid, [(1,1',6,6',7,7'-hexahydroxy-5,5'-diisopropyl-3,3'-dimethyl[2,2'-

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binaphthalene]-8,8'diyl)dimethylidyne]dihydrazide. At column 13326a, see the instant compound.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by

✓ Ca 11458 f. (See Reference X). Ca 11458f discloses the instant compound,

Isonicotinic acid, (1, 4-naphthylenedimethylidyne) dihydrazide. At column 11458f, see the instant compound.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by

✓ CA 58:12508g. (See Reference U1). CA 58:1250g discloses the instant compound,

Isonicotinic acid, (1, 4-naphthylenedimethylidyne) dihydrazide. At column 11458f, see the instant compound.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by CA 51:14721c. (See Reference V1). CA 51:14721c discloses the instant compound, Isonicotinic acid, [(2-ethoxy-1-naphthyl)methylene]hydrazide, 1-oxide. At column 14721c, see the instant compound.


The IDS at paper no. 11 has been considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

Binta Robinson


July 30, 2002



ALAN L. ROTMAN
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